



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,873	04/03/2001	Alan Gary Blahey	P1998J096	6495
27810	7590	07/18/2006	EXAMINER	
EXXONMOBIL RESEARCH AND ENGINEERING COMPANY			TOOMER, CEPHIA D	
P.O. BOX 900			ART UNIT	PAPER NUMBER
1545 ROUTE 22 EAST			1714	
ANNANDALE, NJ 08801-0900			DATE MAILED: 07/18/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/806,873	<b>Applicant(s)</b> BLAHEY ET AL.	
	<b>Examiner</b> Cephia D. Toomer	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,9,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,9,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is in response to the amendment filed April 20, 2006 in which claims 6 and 14 were amended. The 103 rejection over Inoue is withdrawn in view of Applicant's arguments.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blahey (5,726,133).

Blahey teaches a low ash natural gas engine oil and additive system comprising a lubricating oil basestock having a kinematic viscosity at 100 °C of about 5 to 16 cSt, a minor amount of a detergent comprising a mixture of a low TBN alkali or alkaline earth metal salt and at least one more neutral alkali or alkaline earth metal salt, a viscosity index improver and a phenolic antioxidant (see abstract; col. 2, lines 1-11, 25-27). The first detergent has a TBN of about 250 and the second detergent has a TBN that is about half of the first detergent and the mixture contributes a sulfated ash amount of 0.1 to 0.6% (see col. 2, lines 31-67; col. 3, lines 1-9). The lubricating oil may be a mixture of hydrocrackate and solvent refined oils (see col. 3, lines 14-20, 46-58). The phenolic antioxidant is present in the composition in an amount from 0.05 to 1.5 vol.%, the

viscosity index improver (VII) is present in an amount up to 15 vol % (see col. 4, lines 27-35, 58-67) and the antiwear agent is present in an amount from about 0.05 to 1.5 vol. % (see col. 4, lines 42-48). The compositions exemplified in table 1 have a KV of 13.5 at 100 °C. Blahey teaches the limitations of the claims other than the differences that are discussed below.

Blahey differs from the claims in that he does not specifically teach that the amount of the viscosity index improver present in the composition will not produce a multi-grade gas engine oil. However, no unobviousness is seen in this difference because Blahey teaches that the viscosity index improver is any polymer that imparts multifunctional viscosity properties to the finished oil, not necessarily multi-grade function but multifunctional from the perspective of offering secondary lubricant performance features such as additional dispersancy.

3. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the claims distinguish over the art because the claims contain the presence of both phenolic antioxidant and viscosity index improver so as to lubricate a gas engine using an oil which exhibits enhanced life. Applicant discusses the oils of Examples 1-13 of the specification.

Applicant and Blahey both use the same additive package. Applicant discloses at page 13, first full paragraph that the commercial additive Oloa 1255 imparts a net treat rate of about 0.4 vol.% phenolic antioxidant. Given that Blahey also uses Oloa 1255, it would be reasonable to expect that Blahey uses only phenolic antioxidants and the oils of his invention would exhibit enhanced life.

With respect to the viscosity index improver, Blahey teaches that the viscosity index improver is any polymer that imparts multifunctional viscosity properties to the finished oil, not necessarily multi-grade function but multifunctional from the perspective of offering secondary lubricant performance features such as additional dispersancy. Therefore, it would be reasonable to expect that the amount of the viscosity index improver would not be present in the oil in an amount that produces a multi-grade engine oil composition.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

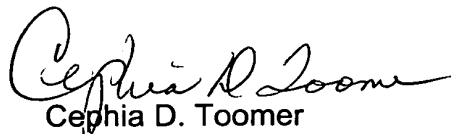
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

Art Unit: 1714

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

09806873\20060710